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| 10/719,164      | 11/21/2003  | William R. Graves    | 480927.00002        | 2344             |

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EXAMINER

HAAS, WENDY C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1661

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/719,164

Applicant(s)

GRAVES ET AL.

Examiner

Wendy C. Haas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Drawings***

The new corrected drawings filed in response to the previous Office Action are accepted.

***Claim Rejections - 35 USC § 102***

The claim remains rejected under 35 U.S.C. 102(b) as failing to patentably distinguish over Huxley et al, for reasons of record. The Examiner finds no patentable distinction between the description of the claimed plant in the present specification and the description of the species *Alnus maritima* in Huxley et al.

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***Objection to the Disclosure***

**37 CFR 1.163**

**The following is a quotation of section (a) of 37 CFR 1.163:**

*(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.*

**35 USC § 112**

**The following is a quotation of the first paragraph of 35 U.S.C. 112:**

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

**The following is a quotation of the second paragraph of 35 U.S.C. 112:**

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

**As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164**

**(reproduced below) are controlling:**

*The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.*

**In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited.**

**The following is a quotation of 35 U.S.C. 162:**

*No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.*

The disclosure remains objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical

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description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically, from the previous office action:

A. Applicants must provide color designations with reference to the employed color chart for the following botanical structures of the claimed plant: Trunk, branches, petioles, stipules (upper and lower surface, if any), upper and lower leaf veins, lower side of mature leaf, colors of fall foliage variegation, new branch growth, roots, and a complete description of the catkin coloration (multiple colors are illustrated) as well as the peduncles of the catkin. As the claimed plant is monoecious, the male and female catkins must be separately described. More information is required. Applicants argued that the color designations already of record are sufficient to patentably distinguish the claimed plant. The Examiner disagrees.

B. Page 3, lines 5-12: Applicants appear to describe the species in general rather than the claimed plant. This description of the species constitutes the bulk of the descriptive portion of the disclosure. Applicant must provide a detailed description of the specific plant claimed. The description must state the age of the plant described and its location of culture as well as the time of year the plant was observed and the specific cultural conditions (i.e. light, temperature, water, etc.) the plant was grown under. The description should include, but is not limited to:

- Root size, shape, color
- Plant height and diameter
- Trunk color, texture, diameter at a given height from the ground
- Approximate number of branches

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- Branch color, length, diameter and internode distance
- Petiole color, length and diameter
- Leaf color, venation, shape, margin shape, apex shape, base shape, texture, length, diameter
- Number of catkins (male and female)
- Catkin shape, colors, number of flowers per inflorescence, pollen produced, time and length of bloom
- Pedicel length, diameter, color
- Fruit/seed number, shape, color, viability
- Disease resistance
- Heat/Cold/Salt tolerance

Applicant made no amendments to the specification in response to the previous Office Action.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

***Claim Rejection***

**35 U.S.C. § 112, 1st and 2nd Paragraphs**

Claim 1 remains rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced in the objection to the drawings.

***Remarks***

Applicants' arguments have been considered but are not found persuasive for the following reasons:

(1) On page 4 of the arguments, Applicant argues that Huxley et al. does not anticipate the claimed plant because it provides only a general description of the species – but admits on page 5 that the botanical description is limited to a recitation of “the species in general”, that this description is a reasonably comprehensive botanical description of the claimed plant and that “[n]one of these descriptions are intended to be distinctive of this variety of plant from the species or subspecies in general. Accordingly, it appears that Huxley et al. properly anticipates the claimed plant.

(2) Applicant argues that the claimed plant is distinctive from other plants included in the trial discussed in the Specification. There is nothing that precludes the other plants in the trial from being distinctive from the species in general, and thus from the claimed plant. Accordingly, the Examiner does not find this argument to be persuasive.

(3) Applicant argues that the growth rate, foliation density and canopy volume of the claimed plant distinguish it from the species in general. The examiner has considered this assertion, but is unable to make a definitive determination of patentability of the claimed plant based on these characteristics alone in the absence of a more complete botanical description, especially given that the claimed plant both appears to be anticipated by the species and that applicant has indicated in the botanical description provided that there is no difference between the claimed plant and the species in general.

(4) As a note to the Applicant, while the claim amendment provided is acceptable, it provides no additional patentable distinction for the claimed plant. The claim in a plant application under 35 U.S.C. 161 encompasses the plant *as illustrated and described* and thus the claim scope is the entirety of the Specification and Drawings.

The application remains rejected for the reasons set forth above.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday from 9:30 to 5:00. The Examiner anticipates being unavailable on Maternity Leave in November and December of 2006.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WENDY HAAS  
PATENT EXAMINER



W. C. Haas, J.D.  
Patent Examiner  
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